

Remarks

Claims 1-8 were pending in the subject application. By this Amendment, the applicants have amended claims 1, 7, and 8, and canceled claim 6. No new matter has been added by these amendments. Support for the amendments can be found throughout the original specification (see, for example, page 1, lines 6-14; page 4, line 30 through page 5, line 15; and original claim 6). Accordingly, claims 1-5 and 7-8 are before the Examiner for further consideration.

The amendments to the claims have been made in an effort to lend greater clarity to the claimed subject matter and to expedite prosecution. These amendments should not be taken to indicate the applicant's agreement with, or acquiescence to, the rejections of record. Favorable consideration of the claims now presented, in view of the remarks and amendments set forth herein, is earnestly solicited.

Claims 1-5 have been rejected under 35 U.S.C. §102(b) as being anticipated by Miyazawa *et al.* (JP 2000-303259). The applicants respectfully request reconsideration.

By this Amendment, claim 1 has been amended to recite that, "after the addition of the cellulose acetate, the homogeneous stirring is carried out for at least 2 hours, and the spinning solution is ripened by allowing it to stand at a temperature of 30 °C to 70 °C for 28 to 38 hours." These important process parameters are discussed at pages 4 and 5 of the subject specification. Miyazawa *et al.*, on the other hand, fail to teach or even suggest these advantageous elements.

As Examiner is aware, it is a basic premise of patent law that in order to anticipate, a single reference must disclose within the four corners of the document each and every element and limitation contained in the rejected claim. *Scripps Clinic & Research Foundation v. Genentech Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). As discussed above, Miyazawa *et al.* do not disclose certain aspects of the claimed invention. Additionally, the applicants note that this rejection was not applied to claim 6, as previously presented, and claim 6 included limitations now present in claim 1.

Accordingly, reconsideration and withdrawal of the rejection of claims 1-5 is respectfully requested.

Claim 7 has been rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over Miyazawa *et al.* (JP 2000-303259). The applicants respectfully traverse because the cited reference does not teach or suggest the claimed invention.

By this Amendment, claim 7 has been amended to recite that, “after the addition of the cellulose acetate, the homogeneous stirring is carried out for at least 2 hours, and the spinning solution is ripened by allowing it to stand at a temperature of 30 °C to 70 °C for 28 to 38 hours.” As discussed at page 5, lines 2-7, the inventors of the subject invention have discovered that these conditions have a direct influence on the advantageous properties of the elastic fiber, including increase in modulus and improvement in heat and alkali resistance. These process parameters are neither disclosed nor contemplated by Miyazawa *et al.*

Additionally, claim 7 also recites that the elastic fiber has “high modulus, alkali resistance, and heat resistance.” In the fiber of Miyazawa *et al.*, on the other hand, a skilled artisan would readily recognize that the modulus of the fiber is very low (see, e.g., Tables 1 and 2), and there is no discussion of the fiber having any alkali or heat resistance properties. In fact, Miyazawa *et al.* teach preparing their elastic fiber by treating an acetyl-cellulose-containing fiber with an alkali (see, e.g., paragraph [0045]). Thus, not only is the fiber of Miyazawa *et al.* not alkali resistant, altering the process steps in Miyazawa *et al.* to attempt to achieve such a property would render the process inoperable for its intended purpose. A skilled artisan would not have modified Miyazawa *et al.* to attain a fiber with high alkali resistance since the final fiber could not even be produced by the Miyazawa *et al.* method that includes treating a fiber with an alkali.

Accordingly, reconsideration and withdrawal of the rejection of claim 7 is respectfully requested.

Claim 6 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Miyazawa *et al.* (JP 2000-303259) in view of Brotherton *et al.* (U.S. Patent No. 3,256,220). The applicants respectfully traverse this ground for rejection.

Though claim 6 has been canceled, claim 1 has been amended to include the limitations previously presented in claim 6. Additionally, by this Amendment, claim 1 has been amended to recite that the fiber has “high modulus, alkali resistance, and heat resistance.” Miyazawa *et al.*, on

the other hand, teach preparation of an elastic fiber by treating an acetyl-cellulose-containing fiber with an alkali (see, e.g., paragraph [0045]). Thus, not only is the fiber of Miyazawa *et al.* not alkali resistant, modifying the process steps in Miyazawa *et al.* to attempt to achieve such a property would render the process inoperable for its intended purpose. Moreover, the fibers of Miyazawa are low modulus fibers, as a skilled artisan would recognize (see, e.g., Tables 1 and 2).

Furthermore, the Action asserts at page 8 that ripening the spinning solution by allowing it to stand at a temperature in the claimed range for 28 to 38 hours is not critical and is obvious as the result of routine experimentation. The applicants respectfully disagree and direct the Examiner's attention to page 5, lines 2-15 of the subject specification. The inventors of the present invention have discovered that using the claimed process parameters, including the length of time for the ripening of the spinning solution, is critical to the advantageous results of high modulus, alkali resistance, and heat resistance. Thus, the ripening time is a critical element, and a skilled artisan would not have found it obvious as the result of routine experimentation.

Accordingly, reconsideration and withdrawal of the rejection based on Miyazawa *et al.* in view of Brotherton *et al.* is respectfully requested.

Claim 8 has been rejected under 35 U.S.C. §103(a) as being unpatentable over Mares *et al.* (U.S. Patent No. 5,531,998) in view of Miyazawa *et al.* (JP 2000-303259). The applicants respectfully traverse because the cited reference does not teach or suggest the claimed invention.

By this Amendment, claim 8 has been amended to recite that, "after the addition of the cellulose acetate, the homogeneous stirring is carried out for at least 2 hours, and the spinning solution is ripened by allowing it to stand at a temperature of 30 °C to 70 °C for 28 to 38 hours." As discussed above with respect to the rejection of claim 7, the inventors of the subject invention have discovered that these conditions have a direct influence on the advantageous properties of the elastic fiber, including increase in modulus and improvement in heat and alkali resistance. These process parameters are neither disclosed nor contemplated in the combination of Mares *et al.* and Miyazawa *et al.*

Additionally, claim 8 also recites that the elastic fiber has “high modulus, alkali resistance, and heat resistance.” In the fiber of Miyazawa *et al.*, on the other hand, the modulus of the fiber is very low (see, e.g., Tables 1 and 2), and there is no discussion of the fiber having any alkali or heat resistance properties. In fact, Miyazawa *et al.* teach preparing their elastic fiber by treating an acetyl-cellulose-containing fiber with an alkali (see, e.g., paragraph [0045]). Thus, not only is the fiber of Miyazawa *et al.* not alkali resistant, altering the process steps in Miyazawa *et al.* to attempt to achieve such a property would render the process inoperable for its intended purpose. A skilled artisan would not have modified Miyazawa *et al.* to attain a fiber with high alkali resistance since the final fiber could not even be produced by the Miyazawa *et al.* method that includes treating a fiber with an alkali.

Accordingly, reconsideration and withdrawal of the rejection of claim 8 is respectfully requested.

In view of the foregoing remarks and the amendment above, the applicants believe that the currently pending claims are in condition for allowance, and such action is respectfully requested.

The Commissioner is hereby authorized to charge any fees under 37 CFR §§1.16 or 1.17 as required by this paper to Deposit Account No. 19-0065.

The applicants also invite the Examiner to call the undersigned if clarification is needed on any of this response, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,



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